

ESTTA Tracking number: **ESTTA498746**

Filing date: **10/08/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Snap-on Incorporated
Granted to Date of previous extension	10/07/2012
Address	2801 80th Street Kenosha, WI 53141-1410 UNITED STATES

Attorney information	Gina L. Durham DLA Piper LLP (US) P.O. Box 64807 Chicago, IL 60664-0807 UNITED STATES ch.tm@dlapiper.com, gina.durham@dlapiper.com, erin.lothson@dlapiper.com, debbie.leget@dlapiper.com, michael.geller@dlapiper.com Phone:(312) 368-4000
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**Applicant Information**

Application No	79102349	Publication date	04/10/2012
Opposition Filing Date	10/08/2012	Opposition Period Ends	10/07/2012
International Registration No.	1090161	International Registration Date	06/29/2011
Applicant	BST International GmbH Heidsieker Heide 53 33739 Bielefeld  GERMANY		

**Goods/Services Affected by Opposition**

<p>Class 009. All goods and services in the class are opposed, namely: Measuring, signal and control apparatus and devices for the observation of material widths, namely, video observation apparatus in the nature of video cameras and charged coupled device (CCD) cameras; devices for register measurement and register adjustment, namely, video and CCD cameras; devices for colour measurement, namely, video cameras; bar code scanners, devices for the identification of printing errors, namely, video cameras and scanners; line scan cameras; lighting devices for line scan cameras; devices for recording and reproducing images, namely, CCD cameras; data processing devices, namely, computers and computer software for width monitoring, excluding the monitoring of machines and machine tools, plants and systems consisting of machines and machine tools for materials tooling by means of laser technology, not including integrated circuits, semiconductors, or microprocessors</p>
<p>Class 042. All goods and services in the class are opposed, namely: Design and development of computer hardware and software</p>

## Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1834459	Application Date	09/10/1992
Registration Date	05/03/1994	Foreign Priority Date	NONE
Word Mark	SHARK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1992/12/04 First Use In Commerce: 1992/12/30 ultrasonic and spark generating, measuring and signaling apparatus and instruments and parts thereof, all for use in determining vehicle dimensions		

U.S. Registration No.	1894954	Application Date	04/21/1994
Registration Date	05/23/1995	Foreign Priority Date	NONE
Word Mark	SHARK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1992/12/04 First Use In Commerce: 1992/12/30 ultrasonic and spark generating, measuring and signalling apparatus and computer software and parts therefor, all for use in determining vehicle dimensions		

Attachments	74312587#TMSN.gif ( 1 page )( bytes ) Snap-on - Notice of Opposition to SHARK and design.pdf ( 6 pages )(1318996 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Gina L. Durham/
Name	Gina L. Durham
Date	10/08/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re: Serial No. 79/102,349  
Mark: SHARK (and design)  
Published: April 10, 2012

<b>SNAP-ON INCORPORATED,</b>	)	
	)	
<b>Opposer,</b>	)	
	)	Opposition No.
<b>v.</b>	)	
	)	Mark: SHARK (and design)
<b>BST INTERNATIONAL GMBH,</b>	)	
	)	
<b>Applicant.</b>	)	

**NOTICE OF OPPOSITION**

U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451

Snap-on Incorporated (“Opposer”), believes that it is or will be damaged by U.S. federal trademark application Serial No. 79/102,349 (“the ‘349 Application”) filed with the U.S. Patent and Trademark Office (hereinafter “PTO”) on June 29, 2011 by BST International GmbH (hereinafter “Applicant”), for the mark SHARK (and design) (hereinafter “Applicant’s Mark”) in connection with “measuring, signal and control apparatus and devices for the observation of material widths, namely, video observation apparatus in the nature of video cameras and charged coupled device (CCD) cameras; devices for register measurement and register adjustment, namely, video and CCD cameras; devices for colour measurement, namely, video cameras; bar code scanners, devices for the identification of printing errors, namely, video cameras and scanners; line scan cameras; lighting devices for line scan cameras; devices for recording and reproducing images, namely, CCD cameras; data processing devices, namely, computers and computer software for width monitoring, excluding the monitoring of machines and machine

tools, plants and systems consisting of machines and machine tools for materials tooling by means of laser technology, not including integrated circuits, semiconductors, or microprocessors” in International Class 9 and “design and develop of computer hardware and software” in International Class 42. (collectively “Applicant’s Services”). Opposer hereby opposes said application.

As grounds for the Opposition, it is alleged that:

**OPPOSER AND ITS RIGHTS IN SHARK**

1. Opposer is a corporation organized under the laws of Delaware, with a principal place of business at 2801 80th Street, Kenosha, Wisconsin 53188. Opposer is a leading global innovator, manufacturer and marketer of tools, diagnostics and equipment solutions. Opposer’s product lines include hand and power tools, tool storage, diagnostics software, information and management systems, shop equipment and other solutions for vehicle manufacturers, dealerships and repair centers, as well as customers in industry, government, agriculture and construction.

2. Opposer owns two registrations for the SHARK Marks, including Reg. No. 1,834,459 for SHARK (and design) covering “ultrasonic and spark generating, measuring and signaling apparatus and instruments and parts thereof, all for use in determining vehicle dimensions” in International Class 9 (registered May 3, 1994); and Reg. No. 1,894,954 for SHARK covering “ultrasonic and spark generating, measuring and signaling apparatus and instruments and parts thereof, all for use in determining vehicle dimensions” in International Class 9 (registered May 23, 1995).

3. Since at least December, 1992, the marks SHARK and SHARK (and design) (the “SHARK Marks”) have been used in interstate commerce in the United States in connection with the goods identified in the registrations listed above.

4. The foregoing registrations are valid, subsisting and incontestable pursuant to 15 U.S.C. § 1065.

5. Opposer or its predecessor has continuously used and is using the SHARK Marks in interstate commerce in connection with the goods and services described in Opposer's registrations.

### **COUNT I**

#### **APPLICANT'S MARK CREATES A LIKELIHOOD OF CONFUSION WITH OPPOSER'S MARK**

6. Opposer realleges paragraphs 1 through 5 as paragraph 6 of this Count I.

7. The federal registrations identified above provided, at the very least, constructive notice to Applicant of Opposer's rights in and to the SHARK Marks.

8. Despite Opposer's prior use and registration of the SHARK Marks, on June 29, 2011, Applicant filed the '349 Application for the mark SHARK (and design) for "measuring, signal and control apparatus and devices for the observation of material widths, namely, video observation apparatus in the nature of video cameras and charged coupled device (CCD) cameras; devices for register measurement and register adjustment, namely, video and CCD cameras; devices for colour measurement, namely, video cameras; bar code scanners, devices for the identification of printing errors, namely, video cameras and scanners; line scan cameras; lighting devices for line scan cameras; devices for recording and reproducing images, namely, CCD cameras; data processing devices, namely, computers and computer software for width monitoring, excluding the monitoring of machines and machine tools, plants and systems consisting of machines and machine tools for materials tooling by means of laser technology, not including integrated circuits, semiconductors, or microprocessors" in International Class 9 and

“design and development of computer hardware and software” in International Class 42 based on a request for extension of protection to the United States.

9. The grant of a registration to Applicant for Applicant’s Mark should be denied on the grounds of Opposer’s prior use of the SHARK Marks. The mark sought to be registered by Applicant is confusingly similar to the SHARK Marks, and the use of Applicant’s mark by Applicant is likely to cause confusion or mistake in the minds of the public and to lead the public and prospective purchasers to believe that Applicant's services are those of Opposer or are endorsed, sponsored or otherwise affiliated or connected with Opposer, or that Opposer’s goods and services are associated with Applicant, all to the damage and injury of the purchasing public and to the damage and injury of Opposer.

10. The grant of a registration to Applicant for the SHARK (and design) mark should be denied based on a likelihood of confusion with the prior SHARK Marks.

**WHEREFORE**, Opposer files this Notice of Opposition and prays that the aforesaid application of Applicant herein opposed, be rejected; that no registration be issued thereon to Applicant; and for such other and further relief as may be deemed just and proper.

The filing fee of \$600.00 to cover the filing fees in this Notice of Opposition against the ‘349 Application and any additional fees required for this Notice of Opposition should be charged to Deposit Account No. 18-2284. Please address all correspondence regarding this opposition to:

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October 8, 2012

Respectfully submitted,

**SNAP-ON INCORPORATED**

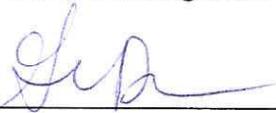
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Attorneys for Opposer

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of this correspondence is being deposited with the United States Postal Service as First-Class Mail in an envelope addressed to Applicant's attorney at the address of record at the PTO, John W. McGlynn, RatnerPrestia, 1007 Orange Street, Suite 1100, P.O. Box 1596, Wilmington, Delaware 19899 on October 8, 2012.

  
\_\_\_\_\_  
Signature

Gina Durham  
\_\_\_\_\_  
Name

October 8, 2012  
\_\_\_\_\_  
Date of Signature